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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/734,107 | 12/15/2003 | Daniel Brun-Buisson | 1435-140-1 | 4864 |

22852 7590 04/15/2004

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EXAMINER

DAVIS, BRIAN J

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1621

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/734,107 | Applicant(s) BRUN-BUISSON ET AL. | |
| | Examiner Brian J. Davis | Art Unit 1621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/169,579.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2/15/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

The specification is objected to because it does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by The Merck Index, 12th edition entry No. 9798, cited by the applicant in the IDS

Triethanolamine is an old and well-known compound in the chemical arts. Applicant's recitation of triethanolamine having particular purity characteristics is not a patentable distinction over an old and well-known compound. Case law is clear on this point: To be patentable, a novel form of an old compound must possess a new utility or a utility of a different type. There are a number of decisions holding that where the purification of an old product results in a mere change in degree in its properties, the purified form is unpatentable, for example:

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Ex parte Windhaus, 15 USPQ 45 (POBA 1931); *In re Ridgeway*, 76 F.2d 602, 25 USPQ 202 (CCPA 1935); *In re Mertz*, 97 F.2d 599, 38 USPQ 143 (CCPA 1938); *In re Macallum*, 102 F.2d 614, 41 USPQ 146 (CCPA 1939); *In re King*, 107 F.2d 614, 43 USPQ 400 (CCPA 1939); *Ex parte Sparhawk*, 64 USPQ 339 (POBA 1945); *In re Johnson*, 94 F.2d 978, 37 USPQ 75 (CCPA 1938); *Ex parte Cavillito*, 89 USPQ 449 (POBA 1950); *Ex parte Snell*, 86 USPQ 496 (POBA 1950); *In re Fisher*, 307, F.2d 948, 135 USPQ 22 (CCPA 1962); *Ex parte Hartop*, 139 USPQ 525 (POBA 1962); *Ex parte Siddiqui*, 156 USPQ 426 (POBA 1966); *Ex parte Schmidt-Kastner*, 153 USPQ 473 (POBA 1963). *In re Weijland*, 587 OG 3, 33 CCPA 837, 154 F.2d 133; 1946 CD 175, 69 USPQ 86; *Ex parte Hald*, Paper 15 in US 2,647,145.

See also: *In re Papesch*, 315, F.2d 381, 137 USPQ 43 (CCPA 1963) (A compound and its properties are inseparable).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 **BRIAN DAVIS**
PRIMARY EXAMINED

Brian J. Davis
April 12, 2004